REMARKS

Claims 1 and 3-7 are pending in this application, of which claims 1 and 5 have been amended. Claim 2 has been canceled. Claims 6-7 have been newly-added.

The Examiner has maintained that this Office Action, which is the first Office Action after filing of an RCE, has been made FINAL. Applicants respectfully request withdrawal of the "FINAL" status because new issues were indicated in the Advisory Action as being presented by the claim amendments presented, but unentered, in Applicants' response filed October 24, 2005. Thus, a new search should have been conducted by the Examiner and Applicants should have been provided at least one opportunity to further amend or argue the patentability of the claims before another FINAL Office Action was mailed.

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not disclosed in the specification.

Applicants respectfully traverse this rejection.

Applicants note that page 4, lines 9-14 disclose the following:

> That is, the present invention relates to a paper for ink jet and electrophotographic recording usable for both the recordings which comprises a support having a cationic resin adhered thereto in a dry adhering amount of 0.5-2.0 g/m^2 and which has a surface resistivity of 1.0 x 10^9 - 9.9 x 10^{13} Ω.

Thus, claim 1 actually recites "a surface resistivity of 1.0 x 10^9 - 9.9 x 10^{13} Ω" (not a surface resistivity of 1.0 x 10^9 - 9.9 x 10^{11} Ω" mentioned in the Office Action. This is supported in the specification on page 6, lines 4-12 and page 24, line 1 to page 25, line 2.

Claim 5 has been amended to recite a surface resistivity of 1.0×10^{10} - 9.9×10^{13} for the recording side of the paper.

The amendments to claims 1 and 5 are supported by all the examples of the present application. In Examples 1-18, using a size press apparatus, a cationic resin is adhered to both sides (irrespective of recording side or non-recording side) of a support; in Example 19, using a rod coater, a cationic resin is adhered to both sides (irrespective of recording side or non-recording side) of a support; and in Examples 1-19, both sides (irrespective of recording side or non-recording side) to which the cationic resin is adhered have a surface resistivity of 1.0×10^{9} - 9.9×10^{13} Ω.

Thus, the 35 U.S.C. § 112, first paragraph, rejection should be withdrawn.

Claims 1 and 5 stand rejected under 35 U.S.C. § 102(b) rejection as anticipated by **Fujioka et al.**

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over **Fujioka et al.** in view of **Shepherd**.

Applicants respectfully traverse these rejections.

The Examiner has urged, among other things, that, although Applicants argued that "the claimed paper should be compared not with the intermediate product, but with the final product of **Fujioka et al.**," the claimed paper "has been compared to the disclosure of **Fujioka et al.** in its entirety."

The Examiner also urges that in **Fujioka et al.**, the coating applied to the base sheet comprising cationic resin is on the recording side of the paper.

Applicants respectfully disagree.

Claim 1, as amended, of the present application, recites that the cationic resin is present on the surface of the support, and the recording paper has a surface resistivity of 1.0×10^9 - 9.9×10^{13} Ω.

In contrast, the final product disclosed in **Fujioka et al.**, which is to be compared with the present invention, is constituted of a paper substrate, an electeroconductive layer and a record forming layer formed on the electeroconductive layer. In **Fujioka et al.**, a cationic resin is contained only in the electeroconductive layer, and the record forming layer is mainly composed of an insulative resin. A cationic resin is not present on the surface of the recording layer. Moreover, **Fujioka et al.** fails to disclose or suggest that the surface resistivity of the recording side of the paper is 1.0×10^9 - 9.9×10^{13} Ω, as claimed in the present invention. There is no motivation in **Fujioka et al.** to lead one of ordinary skill in the art to the present invention with the other respects.

In order to specify the present invention more distinctly from **Fujioka et al.**, claims 6-7 have been newly-added. Support for newly-added claims 6 and 7 can be found on page 1, lines 6-9; page 8, lines 4-14, and Examples 1-19 of the specification of the instant application.

In view of the aforementioned remarks, claims 1 and 3-7 are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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